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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,981	01/17/2001	David K. Swanson	15916-282	5761

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EXAMINER

VRETTAKOS, PETER J

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 01/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/761,981

Applicant(s)

SWANSON, DAVID K.

Examiner

Peter J Vrettakos

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 17-19.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

The instant office action is **non-final** as new art is presented below.

The applicant is requested to disclose cases with similar claimed subject matter to that found in the instant application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over La Fontaine et al. ('267) in view of Goble et al. ('134).

Concerning independent claim 1 and dependent claim 4, LaFontaine et al. (LaFontaine) discloses a surgical probe (see figures 4 and 5) comprising a shaft (14), an electrode (38 or 89), and a tissue cooling apparatus (78) including an outer member (82), a continuous fluid transmission space (illustrated by arrows, 114), an inlet (26), and an outlet (96).

LaFontaine, however, does not disclose a plurality of electrodes on a single embodiment.

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Goble et al. (Goble) discloses an analogous surgical probe or treatment device with a plurality of electrodes (fig. 3-6, 8; elements 24,26,106).

Concerning claim 2, LaFontaine discloses a relatively short shaft (14).

Concerning claim 3, LaFontaine discloses a portion (36) of the shaft that is malleable / pliable. Note column 7 lines 41-47.

Concerning claims 5 and 6, the LaFontaine tissue cooling apparatus (78) comprises a microporous structure (80), Surlyn or Latex as disclosed in column 14 lines 61-63.

Concerning claims 7 and 8, the LaFontaine fluid transmission space defines a substantially constant cross-sectional area between the inlet and the outlet as strongly deduced from figure 5. In other words, all along the shaft (excluding the distal tip (82)) the cross sectional of the fluid transmission space is constant. Moreover, as the fluid transmission space in figure 5 along the shaft envelops the wire lumen (30), it is obvious that the space's cross-sectional area is annularly shaped.

Therefore, at the time of the invention it would have been obvious to modify LaFontaine in view of Goble by including as a design expedient a plurality of electrodes. The motivation would be to afford individual or independent control to the surgeon of each electrode as posited in Goble column 2:23-27.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over La Fontaine et al. ('267) in view of Goble et al. and further in view of Panescu et al. ('267).

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LaFontaine and Goble, which have been described above, neglect to disclose a fluid supply line supported on the exterior of the shaft.

Panescu et al. discloses a surgical probe analogous to LaFontaine and Goble comprising a malleable shaft (22, fig.2a), an electrode (16), a tissue cooling apparatus (60, fig.3a), and fluid supply line (64) supported on the exterior of the shaft. Further, for future reference note that Panescu et al. discloses an outlet lumen (76) in figure 6.

Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify LaFontaine in view of Goble and further in view of Panescu by including an external fluid supply line in order to cool the periphery of the electrode as disclosed in Panescu column 6 lines 42-44.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1 is provisionally rejected under the judicially created doctrine of double patenting over claim 20 of copending Application No. 09/652,099. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: both claims include a shaft, energy transmission devices, and tissue cooling apparatuses with inlets and outlets.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Response to Arguments

Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Vrettakos whose telephone number is 703 605 0215. The examiner can normally be reached on M-F 9-6.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C Dvorak can be reached on 703 308 0994. The fax phone numbers for the organization where this application or proceeding is assigned are 703 746 7013 for regular communications and 703 746 7013 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0858.

Pete Vrettakos
January 2, 2003

PV

Michael Peffley
MICHAEL PEFFLEY
PRIMARY EXAMINER